



PATENT APPLICATION
ATTORNEY DOCKET NO. 22782.NP

2115
#87
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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

<p>ART UNIT: 2115</p> <p>EXAMINER: Chun Cao</p> <p>APPLICANT: Chuck Peters, Steve Fairbanks</p> <p>SERIAL NO.: 09/810,874</p> <p>FILED: March 17, 2001</p> <p>FOR: COORDINATING USER PROFILE MIGRATION WITH DISK IMAGING IN A COMPUTER SYSTEM</p>	<p style="text-align: center;">AMENDMENT</p> <div style="border: 1px solid black; padding: 5px;"><p style="text-align: center;">CERTIFICATE OF MAILING</p><p>DATE OF MAILING: <u>4/28/04</u></p><p>I hereby certify that this paper and fee (along with any paper or fee referred to as being attached or enclosed) is being mailed, postage paid, in a package addressed to Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated above.</p><p style="text-align: right;"><i>Sheila Halterman</i></p><p>Printed Name: <u>Sheila Halterman</u></p></div>
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Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Technology Center 2100

Dear Patent Official:

In response to the Office Action mailed February 23, 2004, Applicants and Assignee respectfully submit the following Amendment and request favorable reconsideration of this application.

Customer Number and Address

Please note that this application should now be associated with Customer Number 20,551, at the address for that Customer Number. The undersigned is already an attorney of record in this case; he has simply changed firms.

Domestic Priority Claim

Please amend the specification by replacing the first paragraph on page 1 by the following replacement paragraph:

This application claims priority to, and incorporates by reference, provisional application serial no. ~~60/~~_____ 60/274,593 filed March 10, 2001 ~~with the same inventors as the present application.~~

Title of Invention

The Office Action asserts that the present title is imprecise but fails to explain which part(s) of the title are unclear to the Examiner. The undersigned respectfully submits that the title is clear and precise. However, if objection to the title is still made after consideration of this Response, would the Examiner please indicate which term(s) in the title are unclear, or suggest an alternative title, or provide some other guidance so that an appropriate agreement can be reached as to the title.

Section 112 Rejection

The Office Action rejects claim 12 under 35 U.S.C. § 112, first paragraph, for lack of enablement. Specifically, the Office Action admits that the application enables deployment of an image of an operating system, but asserts that it fails to enable deployment of an image of an operating system which was not on the target system a minute earlier.

However, the application gives specific examples of such operating system images, such as a "new operating system" (as opposed to "an operating system 104 that is already installed on the computer 100"). *See* Application at page 15 lines 9-20. Rolling back the state of the computer may also result in deployment of an image of an operating system which was not on the target system a minute earlier. *Ibid.* New and rollback operating system images are enabled no less than other operating system images, which the Office admits are enabled.

The undersigned respectfully submits that the application therefore does enable claim 12. The rejection should be withdrawn.

Combination of References for Obviousness Rejection

In the Office Action, a single paragraph on page 4 acknowledges the legal requirement for a suggestion or motivation in the art to support a combination of references under Section 103. But the Office Action provides no such evidence. It merely asserts – without support – that the combination would improve reliability and efficiency. Retroactively defining the motivations of one of skill at the time in terms of advantages which are only now appreciated is not proper. “Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness.” *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 881 (Fed. Cir. 1998).

Even if combining Braun and Murray did improve reliability and efficiency, the Office has given no *evidence* that one of skill who was trying to improve reliability and efficiency would have been led by something specific in the prior art to make that improvement by combining Braun and Murray. For instance, it has not been shown that combining Braun and Murray was the *only* way to improve reliability and efficiency, and the Office Action does not explain why one of skill would have chosen to combine Braun and Murray instead of trying something else.

The mere fact that references can be combined (if that is even true in this case) does not mean the combination is obvious. *M.P.E.P.* § 2143.01. To establish a *prima facie* case of obviousness, the Office must show some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *M.P.E.P.* § 2142.

The *prima facie* case must be based on *evidence*, not on unsupported statements. *See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998) (describing “teaching or suggestion or motivation [to combine]” as an “essential evidentiary component of an obviousness holding”); *In re Rouffet*, 149 F.3d 1350, 1359 (Fed. Cir. 1998) (“the Board must identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them”); *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination “only by showing some objective teaching [leading to the combination]”); *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988) (evidence of teaching or suggestion “essential” to avoid hindsight); *Ashland Oil, Inc. v. Delta*

Resins & Refractories, Inc., 776 F.2d 281, 297 (Fed. Cir. 1985) (district court's conclusion of obviousness was error when it "did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination"). *See also Graham v. John Deere Co.*, 383 U.S. 1, 18 (1966) ("strict observance" of factual predicates to obviousness conclusion required). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight. *See, e.g., Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.").

In short, the Office has not met its burden. No factual evidence of specific suggestions in the art were given to justify the combination of Braun and Murray. Without the necessary factual evidence of a suggestion or motivation for making the combination at the time, the combination is not proper. For at least this reason, the rejections should be withdrawn.

Challenge to Official Notice

In the Office Action discussion of claim 14 on page 4, "Official Notice is taken that rolls the image back to an earlier state is old and well known in the computer art." Applicants and Assignee agree that rollback images were well known, and that deploying rollback images in some manner was also known.

However, it is not agreed that it was known to deploy a rollback image into a partition on a computer which also has another partition that serves as a migration content storage partition as claimed. Pursuant to M.P.E.P. § 2144.03, Applicants and Assignee hereby challenge the official notice to the extent it goes beyond deploying rollback images in some unspecified manner. For instance, the official notice is challenged to the extent the Office asserts it was well-known to deploy a rollback image into a partition on a computer which also has another partition that serves as a migration content storage partition as claimed. The official notice is also challenged to the extent the Office asserts that combining rollback images with the other claim limitations would have been obvious.

Shortcomings of Braun

Even if it were proper to combine Braun and Murray, rejections should be withdrawn because Braun does not teach the “in place” limitation of the claimed invention. As explained in the application at pages 39-40:

The present invention provides tools and techniques to facilitate migration of user profiles to a newly imaged partition on a computer 100. Partition manipulations are used to find space *on the computer 100* to temporarily hold the user profile so it is not destroyed by the imaging. Because the invention performs the profile migration to the new image “*in place*” *on the computer 100*, space on a network server is not needed to hold client profiles. The in place migration can also be initiated remotely using IBM’s LCCM or a similar tool, and migrations can proceed in parallel on multiple clients 100 without requiring synchronization between the clients. Moreover, the *in place migration permits user profile migration on a computer 100 that has no current network connection*, without requiring supplemental temporary storage such as a tape drive.
(emphasis added)

That is, the invention migrates user profiles from a computer in a first state to the *same* computer in a second state. By contrast, Braun teaches migrating from a central database over a network onto a computer being built (e.g., column 3 lines 40-50) or from one computer onto another computer (e.g., column 5 line 48 to column 6 line 24). This is not migration “in place” on a single computer.

Accordingly, the Office should withdraw all rejections that overlooked Braun’s failure to teach “in place” migration.

Conclusion

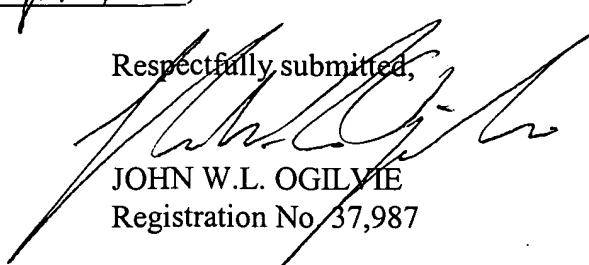
In light of the above, Applicants and Assignee respectfully submit that the application is in condition for allowance. Their silence here as to any point does not signify agreement or acquiescence in the Office’s assertions, and they reserve all arguments.

If any impediment to the allowance of these claims remains after entry of this Response, the Examiner is strongly encouraged to call John Ogilvie at 801-566-6633 so that such matters may be resolved as expeditiously as possible.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 20-0100.

DATED this 28th day of April, 2004.

Respectfully submitted,



JOHN W.L. OGILVIE
Registration No. 37,987

THORPE NORTH & WESTERN, LLP
Customer No. 20,551
P.O. Box 1219
Sandy, Utah 84091-1219
801-566-6633 (voice)
801-566-0750 (fax)

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